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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re the application of:

Confirmation No.: 6969

Del Soldato *et al.*

Group Art Unit: Unknown

Application Serial No.: 10/522,986

Examiner: Unassigned

Filed: February 2, 2005

Attorney Docket No.: 026220-00061

For: Process for Preparing Nitrooxyalkyl Substituted Esters of Carboxylic Acids,
Intermediates Useful in Said Process and Preparation Thereof

RENEWED PETITION UNDER 37 C.F.R. §1.47(a)

Mail Stop PETITIONS

June 6, 2006

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

This is in response to the Decision on Petition, dated May 25, 2006, regarding the applicants' Petition under 37 C.F.R. § 1.47(a) filed September 15, 2005 requesting acceptance of the enclosed Oath/Declaration containing the signature of inventors Giancarlo SANTUS and Francesca BENEDINI, in response to the Notification of Missing Requirements dated August 8, 2005, which requested an oath/declaration.

The PCT Legal Examiners Richard Cole and George M. Dombroske acknowledged that, in the previously filed Petition, the applicants satisfied the following requirements of 37 C.F.R. §1.47(a):

- (1) the requisite petition fee under 37 C.F.R. § 1.17(h);
- (2) a statement of the last known address of Piero DEL SOLDATO, the nonsigning inventor; and

(3) an oath or declaration by each 37 C.F.R. § 1.47(a) applicant on his/his own behalf and on behalf of the non-signing inventor.

PCT Legal Examiner Richard Cole and George M. Dombroske stated, however, that the Applicants have not satisfied the requirement that "factual proof that the missing join inventor refuses to execute the application or cannot be reached after diligent effort." The assertion is made that "neither the 'Affidavit' nor the supporting documentation clearly establishes that any of the documents in question pertained to the instant application number" (Decision, page 2, last full paragraph).

However, Applicants respectfully submit that the previously filed May 2, 2005 and May 23, 2005 letters to Piero DEL SOLDATO (with the accompanying translation) specifically disclose the following paragraph:

Our ref. NP0004 titled "PROCESS FOR PREPARING NITROXYALKYL SUBSTITUTED ESTERS OF CARBOXYLIC ACIDS, INTERMEDIATES USEFUL IN SAID PROCESS AND PREPARATION THEREOF" - 2 documents: USA/Assignment and Declaration and text of the patent.

(emphasis added). Further, page 2 of the Affidavit of Maria Teresa Noro discloses the following:

ns. rif. NP0004 entitled "PROCESS FOR PREPARING NITROXYALKYL SUBSTITUTED ESTERS OF CARBOXYLIC ACIDS, INTERMEDIATES USEFUL IN SAID PROCESS AND PREPARATION THEREOF" - 2 documents: USA/Assignment and Declaration and a copy of the entire application (i.e. specification, including claims and drawings).

(emphasis added).

Applicants submit that NP0004, as well as the above disclosed title, specifically references the above-identified patent application, such that the 'Affidavit' and the supporting documentation clearly establishes that the documents sent to Piero DEL

SOLDATO relate to the instant application number. In fact, Applicants note that "NP0004" is cited as Applicant's reference number throughout the previously filed documents of the related PCT Application. As such, Applicants submit that the previously submitted Affidavit of Maria Teresa Noro and the accompanying documents are sufficient factual proof of Piero DEL SOLDATO's refusal to execute the above-identified patent application or that he cannot be reached after diligent effort.

For at least the above reasons, the applicants respectfully request that the Office of PCT Legal Administration grant this petition and forward the file to the Office of Initial Patent Examination (OIPE) for further processing. Any further delay will cause irreparable harm to the invention. If any questions or issues remain, the Office of PCT Legal Administration is respectfully requested to contact the undersigned to help with their resolution.

As this response is filed within two months of the Decision on Petition, the applicants do not believe that a fee is due. If this response is not timely filed, the applicants hereby petition for an appropriate extension of time. The Commissioner is authorized to charge any additional fees or credit any over-payments to Deposit Account No. 01-2300, referencing Attorney Docket No. 026220-00061.

Respectfully submitted,

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